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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,289	11/13/2003	Volker Boettiger	DE920020042US1	2031

7590

06/15/2005

John R. Pivnichny
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EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,289

Applicant(s)

BOETTIGER, VOLKER

Examiner

Ahshik Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/13/04 (*initila filing of application*).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/13/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

- 5 1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
10 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 15 3. Claims 1-7, 9-13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Levine (US 6,188,309, hereinafter “Levine”).

Re claims 1, 5, 9, 12, and 16, Levine discloses intelligent credit card comprising a processor 62 and memory 66 (see abstract), either of which stores a PIN code entered by the user (col. 4, lines 7+). The card is in deactivated state (see figure 5). When correct PIN is entered, the
20 card changes to its state to “activated state”. The clerk then swipes the card to retrieve the account number (col. 4, lines 23+). The card is activated for a period of time (see step 135 of figure 5 or step 210 of figure 6; col. 4, lines 63+). Re claim 2, the card becomes activated state only after the PIN is successfully verified (col. 4, lines 23+).

Re claims 2 and 10, credit card number, name or other conventional information stored in
25 the credit card can be considered an authorization code.

Re claim 3, the credit card, in coordination with credit card authorization system, generates authorization code (or a transaction number) to be transmitted (col. 4, lines 51+).

Re claims 4 and 11, the card may use optical transmitting device (col. 1, lines 53-63), wherein in some case, the device may transmit visible beam. The fact that the card is unreadable
5 (col. 1, lines 63+) would be another indication that the card is in de-activated state.

Re claims 6, 7, and 13, the user may perform additional activities via terminal or POS making sure of the purchase amount, etc. while the card is activated.

Claim Rejections - 35 USC § 103

10 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine (US 6,188,309) in view of Housman (US 3,641,499, hereinafter "Housman").

20 Levine fails to specifically teach or fairly suggest that the card erases the authorization code from memory if an unsecure situation is detected.

Housman teaches a transaction card which require precise arranging of contacts, which only the owner of the card would know. Incorrect arrangement of contact would result in Otherwise the card is self-destroyed (see abstract; col. 4, lines 40+; col. 4, lines 62+).

25 In view of Housman's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known self-destruction or self-erasing of

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critical information to the teachings of Levine in order to provide improved security to the card.

Selectively activating of the card as disclosed in Levine provides a certain amount of security.

Without having to enter a PIN personally would be considered another security conscious

characteristics. However, since the PIN code is already stored on the card, loss of card can be

5 potentially more damaging. Unauthorized person may retrieve the PIN number. Accordingly,

incorporating a self-destruction mode would have been an obvious improvement one ordinary

skill in the art could make on the card of Levine to prevent credit card information along with

PIN.

10

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Reilly (US 5,877,482); Rahman et al. (US 5,627,355); Fujioka (US 5,698,836); Hitchcock (US 5,050,207); Tamada et al. (US 5,017,766); Graves (US 5,239,166); Bush et al. (US 5,130,519) disclose smart card systems. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

25 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

30 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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A handwritten signature in black ink, appearing to read 'Ahshik Kim', with a stylized, cursive script.

Ahshik Kim
Patent Examiner
Art Unit 2876
June 13, 2005